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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,145	02/27/2002	Colin J. Meiser	BOC9-2001-0041 (286)	1254
40987	7590	12/13/2006	EXAMINER	
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/085,145

**Applicant(s)**

MEISER ET AL.

**Examiner**

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/27/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments including the Declarations, see papers, filed 9/27/06, with respect to the 103 rejections of claims 1-23 have been fully considered and are persuasive. The rejections of claims 1-23 over (1) D'EON et al in view of NOTARIUS et al has been withdrawn.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**4. Claims 1-10 (method<sup>1</sup>), 11-13 (system<sup>1</sup>), and 14-23 (product<sup>1</sup>) are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) D'EON et al in view of (2) NOTARIUS et al.**

In summary, independent method claim 1 deals with a method of eliciting a response comprising 4 steps:

(a) identifying the available network capacity for transmitting electronic content (information) and receiving consumer responses (information) to the transmitted information;

(b) transmitting the electronic content (information) over the network according to a predetermined campaign;

(c.) concurrently determining the effectiveness of the campaign by identifying consumer responses to the transmitted electronic content (information); and

(d) dynamically modifying the campaign according to (1) the determined effectiveness of the campaign (or (c.)) and (2) the identified available network capacity (or (a)).

**Similarly, D'EON et al** discloses a method of eliciting response in an electronic

(Internet) marketing campaign (advertising) comprising the steps of:

(b) transmitting the electronic content {see col. 1, "*web page .... banner advertisement*" } over the network according to a predetermined campaign;

(c.) concurrently determining the effectiveness of the campaign by identifying consumer responses to the transmitted electronic content (information) {see col. 2, lines 29-32, col. 3, lines 10-16, col. 7, lines 10-14 "*indication ... effectiveness of the advertisement*", Fig. 2, Fig. 6}; and

(d) dynamically modifying the campaign according to (1) the determined effectiveness of the campaign (or (c.) {see col. 1, lines 50-55}). Note that on col. 1, lines 50-55, D'EON et al teaches the step of "*ascertaining which banners are and are not effective in causing a user to make a transactional decision*", therefore, it would have been obvious to improve (modify) the campaign effectiveness by deleting the not effective banners and use only the effective banner in order to be profitable.

D'EON et al fairly teaches the claimed invention except for step (a) and item no. 2 of step (d)

**PRUTHI et al** is cited to teach a method and apparatus for conducting a communication service for business transaction such as marketing {see [0004], [0012] } comprising the steps of:

(a) identifying the available network capacity for carrying out the communication service,

(d) determining real-time analysis of network capacity to enable quick relocation of resources to provide optimal recommendations of network configurations to meet the service quality requirement in a business transaction.

{see [0004-0005, 0012, and especially 0140], Fig. 22, element (2206) "Recommendations"}.

It would have been obvious to modify the teachings of D'EON et al by (a) identifying the available network capacity for transmitting electronic content (information) and receiving consumer responses (information) to the transmitted information and use this information in step (d) as taught by PRUTHI et al to provide optimal recommendations of network configurations to meet the service quality requirement in a business transaction.

As for dep. claim 2 (part of 1 above), which deals with the type of electronic content or information, i.e. marketing campaign such as advertising, this is non-essential to the scope of the claimed invention and is taught in D'EON et al Fig. 1, or PRUTHI et al Fig. 22.

As for dep. claim 3 (part of 1 above), which deals with converting certain format of the electronic information (content), this is non-essential to the scope of the claimed invention and is inherently included in the teachings of D'EON et al /PRUTHI et al when changes form digital to electronic and vice versa.

As for dep. claim 4 (part of 1 above), which deals available network capacity parameters, i.e. bandwidth, this is fairly taught in PRUTHI et al Fig. 22, [0139-0140]. Moreover, the selection of other similar network capacity parameters would have been obvious to a skilled artisan as mere selection of other similar parameters to achieve similar results.

As for dep. claims 5, 10 (part of 1 above), which deal with marketing campaign parameters, i.e. determining a number of received consumer responses, this is taught in D'EON et al Figs. 3-6.

As for dep. claims 6-9 (part of 1 above), which deal with electronic content transmitting parameters, i.e. how the electronic content is transmitted ("... *is transmitted over*"), since they are passively written, they carry little patentable weight to the scope of the claimed invention which is eliciting a response. Moreover, these are fairly taught in D'EON et al Fig. 1, col. 1-2 (Internet, Web, etc.) or PRUTHI et al Figs. 22, 1 or 2.

**As for independent program product claim 14**, which the respective computer program product to carry out the method of claim 1 above, it's rejected over the computer program product of D'EON et al /PRUTHI et al as indicated in D'EON et al col. 3, lines 17-35 and further in view of PRUTHI et al.

As for dep. claims 15-23 (part of 14 above), which have similar limitations as in dep. claims 2-10 respectively above, they are rejected for the same reasons set forth in the rejections of dep. claims 2-10 above.

**As for independent system claim 11**, which the respective system to carry out the method of claim 1 above, it's rejected over the system of D'EON et al /PRUTHI et al as indicated in D'EON et al Fig. 1, 2, and further in view of PRUTHI et al Figs. 1-3.

As for dep. claims 12-13 (part of 11 above), which have similar limitations as in dep. claims 7, 3 respectively above, they are rejected for the same reasons set forth in the rejections of dep. claims 7, 3, above.

**5. Claims 1-10 (method<sup>1</sup>), 11-13 (system<sup>1</sup>), and 14-23 (product<sup>1</sup>) are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) ORACLE iMARKETING (Article of 12/1999) in view of (2) PRUTHI et al.**

In summary, independent method claim 1 deals with a method of eliciting a response comprising 4 steps:

(a) identifying the available network capacity for transmitting electronic content (information) and receiving consumer responses (information) to the transmitted information;

(b) transmitting the electronic content (information) over the network according to a predetermined campaign;

(c.) concurrently determining the effectiveness of the campaign by identifying consumer responses to the transmitted electronic content (information); and

(d) dynamically modifying the campaign according to (1) the determined effectiveness of the campaign (or (c.)) and (2) the identified available network capacity (or (a)).

**Similarly, ORACLE iMARKETING** discloses a method of eliciting response in an electronic (Internet) marketing campaign (advertising) comprising the steps of:

(b) transmitting the electronic content {see page 2, "*web page .... banner advertisement*" } over the network according to a predetermined campaign;

(c.) concurrently determining the effectiveness of the campaign by identifying consumer responses to the transmitted electronic content (information) {see page 2, 3<sup>rd</sup> paragraph "*ROI measurement and ... effectiveness is critical*" }; and

(d) dynamically modifying the campaign according to (1) the determined effectiveness of the campaign (or (c.) page 2, 3<sup>rd</sup> paragraph, page 3, 3<sup>rd</sup> paragraph, page 4, 3<sup>rd</sup> paragraph, page 5, last two paragraphs.

**ORACLE iMARKETING** fairly teaches the claimed invention except for: (1) step (a) and (2) item (2) of step (d).

PRUTHI et al is cited to teach a method and apparatus for conducting a marketing campaign (advertisement) comprising the steps of:

(a) identifying the available network capacity for carrying out the marketing campaign (advertisement),

(d) determining real-time analysis of results to enable quick relocation of resources to successful campaigns {see [0584], [0671, 0672, 0674, 0683-0679]}.

**PRUTHI et al** is cited to teach a method and apparatus for conducting a communication service for business transaction such as marketing {see [0004], [0012] } comprising the steps of:

(a) identifying the available network capacity for carrying out the communication service,

(d) determining real-time analysis of network capacity to enable quick relocation of resources to provide optimal recommendations of network configurations to meet the service quality requirement in a business transaction.

{see [0004-0005, 0012, and especially 0140], Fig. 22, element (2206)

"Recommendations"}.

It would have been obvious to modify the teachings of ORACLE iMARKETING by (a) identifying the available network capacity for transmitting electronic content (information) and receiving consumer responses (information) to the transmitted information and use this information in step (d) as taught by PRUTHI et al to provide

optimal recommendations of network configurations to meet the service quality requirement in a business transaction.

As for dep. claims 2-10 (part of 1 above), they are rejected for the same reasons set forth above.

**As for independent program product claim 14**, which the respective computer program product to carry out the method of claim 1 above, it's rejected over the computer program product of ORACLE iMARKETING /PRUTHI et al.

As for dep. claims 15-23 (part of 14 above), which have similar limitations as in dep. claims 2-10 respectively above, they are rejected for the same reasons set forth in the rejections of dep. claims 2-10 above.

**As for independent system claim 11**, which the respective system to carry out the method of claim 1 above, it's rejected over the system of ORACLE iMARKETING / PRUTHI et al as indicated in ORACLE iMARKETING page 1 or PRUTHI et al Figs. 22, 1-3.

As for dep. claims 12-13 (part of 11 above), which have similar limitations as in dep. claims 7, 3 respectively above, they are rejected for the same reasons set forth in the rejections of dep. claims 7, 3 above.

No claims are allowed.

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6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
December 8, 2006

  
DEAN T. NGUYEN  
PRIMARY EXAMINER